

REMARKS

Claims 15-27 were pending in the case at the time of the Office Action, claims 1-14 have been previously cancelled. Claims 15-27 were rejected. In this paper, claim 15 has been amended and claims 16-27 have been cancelled.

Double Patenting

Claims 15-27 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U. S. Patent No. 6,329,425.

This rejection is overcome, at least, for the following reasons.

A Terminal Disclaimer over claims 1-7 of U.S. Patent No. 6,329,425 accompanies this response.

Rejections under 35 U.S.C. § 112

Claims 15-27 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office alleges that “the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.”

Specifically, the Office states that the claims are drawn to “A method of inhibiting PMN migration across columnar epithelial and inflammation” in a subject. The Office concludes that the phrase is directed to the treatment of an “unspecified disorder” and that, “in the absence of the understanding the disease to be treated, the artisan would not have accepted that applicant was in possession of the claimed method of use.”

In addition, the Office asserts that “The claims are also drawn to the phrase ‘wherein the lipoxin compound is an analog of natural lipoxin A4, and wherein the analog of lipoxin A4 has metabolic transformation region different from the natural lipoxin A4’ where the phrase does not meet the requirements of the written description for the reasons set forth on pages 4-5 of the office action of February 4, 2009.”

This rejection is overcome, at least, for the following reasons.

First with regard to the statement that “a method of inhibiting PMN migration across columnar epithelial and inflammation” is directed to the treatment of an unspecified disorder, the claims have been amended. Claim 15 now recites: “A method for inhibiting inflammation in a subject caused or contributed to by PMN migration across columnar epithelia.” As amended herein, the claims are directed to an easily undefinable condition, e.g., inflammation when it is accompanied by PMN migration across columnar epithelia. Explicit support for this amendment is found in the specification at, for example, paragraphs [003]-[0010], [0015]-[0031], [0059]-[0066] and in the EXAMPLES beginning at paragraph [0075]. No new matter is added by way of this amendment. The rejection being now overcome, withdrawal is respectfully requested.

Second, with regard to the Office’s contention that “The claims are also drawn to the phrase “wherein the lipoxin compound is an analog of natural lipoxin A₄, and wherein the analog of lipoxin A₄ has metabolic transformation region different from the natural lipoxin A₄” and that as such the requirements of written description are not met, the claims have been amended herein. Claim 15 has been amended to now specifically recite some preferred compounds according to the invention. Further, these compounds were enumerated in the as-filed specification and in the as-filed claims. Therefore, no new matter is added by way of this amendment. Claims 16-27 have been cancelled herein. The rejection being therefore overcome, withdrawal is respectfully requested.

CONCLUSION

In view of the foregoing, it is respectfully submitted that each of the pending claims is in condition for allowance, and a Notice of Allowance is earnestly solicited. The Examiner is invited to contact the undersigned attorney at (612) 321-2237 with any questions, comments or suggestions relating to the referenced patent application.

This response is being submitted on or before December 16, 2009, making this a timely response. It is believed that no fees are due in connection with this filing. If the Commissioner determines that any fee under 37 C.F.R. §§ 1.16 to 1.21 is required for any reason, including any additional fees, including extension fees or other relief which may be required, the Commissioner is hereby authorized to deduct said fee from Fulbright & Jaworski L.L.P. Account No.: 50-1212/BWHI-029/US3 and notify us of the same.

CUSTOMER NUMBER **38824**

Respectfully submitted,

/Colin L. Fairman/

Colin L. Fairman

Reg. No. 51,663

Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
Telephone: (612) 321-2237
Facsimile (512) 536-4598

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